

### **REMARKS**

Claims 1-22 are pending in the above-identified application. Claims 1, 2, 5, 6, 20 and 21 are rejected under 35 U.S.C. §103(a) as being unpatentable over DiNicola et al. (U.S. Pat. No. 4,951,229; hereinafter referred to as “DiNicola”) in view of Ross (U.S. Pat. No. 5,8838,336) and further in view of Nagata (U.S. Pat. No. 6,522,341). Claims 3, 4 and 7-10 are rejected under 35 U.S.C. §103(a) as being unpatentable over DiNicola, Ross and Nagata and further in view of Fowler (“Mixing Heavy and Light Components”). Claims 11-13, 18, 19 and 22 are rejected under 35 U.S.C. §103(a) as being unpatentable over DiNicola, Ross and Nagata and further in view of Sun Microsystems (“Introducing Swing”; hereinafter referred to as “Sun”). Claims 14-17 are rejected under 35 U.S.C. §103(a) as being unpatentable over DiNicola, Ross, Nagata, Fowler and Sun.

Applicants submit that these amendments and remarks overcome all of the Examiner’s outstanding rejections and bring the present Application into condition for allowance. Entry of this amendment and a notice of allowance of all the remaining claims are therefore respectfully solicited.

#### **Rejections Based Upon 35 U.S.C. §103(a)**

With respect to independent claims 1, 5, 12 and 19, the current Office Action, dated February 2, 2009, (O.A.) relies upon DiNicola for the element of a mode in which “images are forwarded in sequence to the display” and a mode in which “images are compiled as a combination of image of at least one of said images.” However, DiNicola is misconstrued as “forwarding images in sequence to the display. Specifically, the cited portion of DiNicola describes a system that can be “configured to display the resulting independent images separately on the display monitor.” This excerpt does not describe the manner, either sequentially or comined, in which the images are “forwarded to the display” but rather merely that which ultimately ends up on the display. Considering the fact that images are dispersed throughout bit planes of DiNicola’s buffer, as shown FIG. 2 and 3, it is unlikely the images are ever separated again prior to display. Further, DiNicola shows an image mixer such as image mixer 32 of FIG. 1 processing the bit planes prior to display. Certainly the images are not separated again one processed by mixer 32.

To further illustrates that DiNicola does not suggest a system in which images are forwarded in sequence to the display, DiNicola's bit planes 1, 2, 3 ... n **24, 26, 28 and 30** are not "buffers" storing "images" in the any sense that would enable them to implement that aspect of the claimed subject matter. DiNicola states:

FIG. 2 and FIG. 3 illustrate the differences between bit encoding using bit plane and lateral bit encoding of picture element data. FIG. 2 illustrates three bit planes 70, 72, and 74. A picture element (pel) corresponding to a given location on the screen is represented by a single bit FIG. 2 the first pel is represented by bits c.sub.0, c.sub.1, c.sub.2. The next pel of the display image would be represented in the next bit position in each plane, namely d.sub.0, d.sub.1, and d.sub.2. **The information stored in any one plane represents only a subset of the information required to create the picture element on the display monitor. None of the planes represent the full structure of the image; it is only the combination of the several planes that allows the final image to be made apparent.**

(col. 4, lines 31-44; *emphasis added*). In other words, even if bit planes **24, 26, 28, 30, 70, 72 and 74**, are sent to mixer 32, either sequentially or as a composite, the technology is irrelevant because DiNicola's bit planes, as described above, do not represent "images" but rather merely elements of images.

Further, the storage techniques employed by DiNicola do not enable "one of said images to [to be] drawn over at least another one of said images" because DiNicola stores images as composites in which a single image is spread among multiple bit planes. In other words, when DiNicola combines bit planes, each bit plane may represent multiple images, which cannot be construed as drawing one image over another and, as explained above, the output of the bit planes end up at mixer 32 rather than a display.

With respect to combining DiNicola with other art to provide the "buffering the composite image prior to display," DiNicola specifically teaches away from this element by claiming that the system provides the benefit of not doing so. The following excerpt illustrates this point:

A hardware implementation of image mixing allows the images to be combined and written directly to the video display monitor without generating an intermediate frame buffer containing the composite image. This technique improves display system efficiency in computer devices with limited processing power because movement of an object in one plane, or changes to the images in any plane, does not require a complete regeneration of an intermediate frame buffer.

(col. 2, line 66 through col. 3, line 6). Therefore, it would be improper to combine DiNicola with other art that describes buffering the composite image.

The O.A. concedes that DiNicola does not teach a “second mode buffering the combination image prior to display” (p.3, lines 23-24) but instead relies upon Ross for this particular element. However, the “hardware cursor” and “overlay” modes of Ross are not analogous to Applicants’ first and second mode because, in Ross, the overlay mode represents the display of alternative images rather than a composite image. Specifically, Ross provides a system in which a second image can be prepared to replace a first image while the first image is being displayed. Obviously, Ross does not suggest “buffering the combination prior to display.” In addition, merely providing a reference to a system in which “switching” may occur is not enough to suggest Applicants’ specific type of shifting. In other words, shifting is not enough and the cited art does not show a shifting between the particular modes described in Applicants’ claimed subject matter.

The O.A. also concedes that DiNicola and Ross do not teach a “combining the two images into one image and buffering the combined image prior to display” (p.4, lines 15-16) but instead relies upon Nagata for as “mixing the two images and then transmitting the combined image to a buffer prior to displaying the image” (p.4, lines 19-19). However, Nagata does not transmit the combined image to a buffer prior to displaying the image. The only thing shown in Nagata is the mixing and the sending from the mixer. In other words, there is no “transmission to a buffer” after the combining and prior to the displaying.

In addition, the combination of DiNicola, Ross and Nagata do not suggest, either alone or in combination, the specific of Applicants’ switching feature because none of these references illustrate both of the modes between which the Applicants’ system is switched. To establish *prima facie* obviousness of a claimed invention under §103(a), all the claim

limitations must be taught or suggested by the prior art. (M.P.E.P., §2143.03, citing *in re Royka*, 490 F.2d 981; 180 U.S.P.Q. 580 (CCPA 1974)). In addition, “**All words in a claim must be considered** in judging the patentability of that claim against prior art.” (*Id.*, citing *In re Wilson*, 424 F.2d 1382, 1385; 165 U.S.P.Q. 494, 496 (CCPA 1970); *emphasis added*). Applicants believe that the cited art fails to meet this standard. For the reasons above, claims 1-22 are allowable over the cited art. In addition to the reasons stated above, claims 2-4, 6-11, 13-18 and 20-22 are allowable because they each depend upon one of the allowable independent claims. Therefore, Applicants respectfully request withdrawal of the §103(a) rejections of claims 1-22.

### CONCLUSION

In light of the amendments and remarks made herein, Applicants submit that all pending claims are allowable and earnestly solicits notice thereof. Applicants are not conceding in this application that the unamended claims are not patentable over the art cited by the Examiner, as the present claim amendments are only for facilitating expeditious prosecution of the allowable subject matter. Applicants respectfully reserve the right to pursue these and other claims in one or more continuation and/or divisional patent applications. A Request for a Two-Month Extension of Time to file this Amendment by July 2, 2009 is being filed and paid for concurrently with this filing. It is believed that no other fees are due with the filing of this Amendment/Response. However, should any other fees be due, the Commissioner is hereby authorized to charge such fees to the deposit account of IBM Corporation, Deposit Account No. 09-0447.

Respectfully submitted,

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